Applicant : David Carver et al.   Attorney's Docket No.: 07442-023001
Serial No. : 09/723,385
Filed   : November 28, 2000
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REMARKS

Prior art Rejections

Claims 308-318, 341-355, and 375-409, and 411-423 are pending, of which claims 308,

347, 380, 406, 414, and 423 are independent claims. Claims 383, 385-387, and 406-422 have

been cancelled in this amendment. All pending claims stand rejected as follows:

- Claims 308-318, 341 -343, 347-355, 375-376, 380, 381, 385-390, 392-409, 411-413, and 423 stand rejected under 102(e) as being anticipated by Swix et al. (U.S. 6,718,551).

- Claims 344 and 377 stand rejected under 103(a) as being unpatentable over Swix in view of Coleman (U.S. 2002/0026351).

- Claims 345, 346, 378, and 379 stand rejected under 103(a) as being unpatentable over Swix in view of Brown et al. (U.S. 6,751,299).

- Claims 382-384 and 414-422 stand rejected under 103(a) as being unpatentable over Swix in view of Dedrick (U.S. 5,724,521).

- Claim 391 is rejected under 103(a) as being unpatentable over Swix in view of Knee et al. (U.S. 2002/0095676).

Applicant agrees that Swix describes targeted advertisements, and a "profile processor"

that issues instructions to deliver particular advertisements to one or more set-top boxes. For

example, Swix describes:

> Profile processor 104 uses an algorithm to systematically examine customer
> profile information, to determine the particular demographic group of the viewer,
> and to choose an advertisement that appeals to the interests of the viewer and the
> demographic group. Once the analysis is complete, profile processor 104 instructs
> file server 102 to deliver a particular advertisement to the set-top box of the
> viewer. Profile processor 104 performs data source analyses and issues
> instructions concurrently among multiple viewers so that multiple viewers
> watching the same show can receive different advertisements. (col. 5, lines 10-
> 21)

However, the only description in Swix of a specific way in which advertisements are bound to inventory is the description of the profile processor selecting an advertisement that has been classified in a given demographic group. Even if one were to infer that the content of each targeted advertisement represents information that enables the advertisement to be classified in a demographic group, there is nothing in Swix to suggest that the classified targeted advertisements include any additional information used for computing a binding function (such as instructions, procedures, and software programs) or any other type of guidance information.

Claims 308 and 347

Claim 308 has been amended to make it clearer that the "additional information used for computing the binding function" included with each advertisement is not merely the advertising content, and claim 347 has been amended to make it clearer that the "guidance information" included with each advertisement is not merely the advertising content. However, the Applicant submits that these amendments merely emphasize what is already clear from the plain meaning of these claims as pending. Therefore, the following arguments also apply to claims 308 and 347 as pending even if the amendment is not entered.

Swix does not disclose or suggest at least "binding inventory with advertisements based at least in part on a binding function, each advertisement including advertising content and additional information used for computing the binding function," as recited in amended claim 308, or "each of the advertisements including advertising content and guidance information; ... and a service binding advertisements to inventory, based at least in part on a binding function computed using the guidance information," as recited in amended claim 347.

For example, with regard to claim 387 (now cancelled), which recites that "the advertising contains both the advertising copy and the one or more of instructions, procedures, and software programs," the Examiner states (on page 7 of the Office Action):

> Regarding claim 387, the targeted advertisements discussed in claims 385 and 386 are also considered "advertising copy" and also includes part of the instructions, where each targeted advertisement includes information that enables the advertisement to be classified in a demographic group (See column 6 lines 8-24 and column 11 lines 23-33) which is used to direct or instruct the profile

processor to create the full instructions needed to bind the advertisements with the inventory.

However, neither of the cited portions of Swix disclose that each of the advertisements includes both advertising content and "additional information used for computing the binding function" (as required by amended claim 308), or includes both advertising content and "guidance information" (as required by amended claim 347). Instead, the first cited portion of Swix (column 6, lines 8-24) describes selecting a demographic group and displaying an advertisement that is customized for the selected demographic group:

> The present invention is a system and method for providing targeted advertisements over networked media delivery systems, such as interactive media delivery systems, conventional cable television networks, wireless cable television networks, home satellite television networks, and other media delivery systems that allow duplex communication (perhaps with the return path via a separate, e.g., telephone, network) to a set-top box coupled to a subscriber's display device, such as a television. As an overview, the present invention records the viewing selections of a subscriber, compiles the viewing selection data along with other available data (e.g., interactive purchasing or questionnaire data), analyzes the data to formulate a customer profile, matches the customer profile to a demographic group, and displays for the customer a bit map or video stream advertisement that is customized for the customer or the customer's demographic group.

The second portion of Swix (column 11, lines 23-33) similarly describes delivering an advertisement classified under a certain demographic group:

> The selection of a bit map or video advertisement depends largely on the individual customer profile and the library of available advertisements. Both the customer profiles and the available advertisements are classified in demographic groups. Thus, the present invention delivers advertisements classified under a certain demographic group to subscribers having customer profiles classified under the same demographic group. Preferably, the volume of advertisements in the library is large enough to satisfy a large number of demographic groups, thereby allowing more customized advertisements.

Thus, instead of including the "additional information used for computing the binding function" or "guidance information" with the advertising content of each advertisement, Swix describes a different approach in which the advertisements have been classified into

demographic groups without any suggestion that anything other than the advertising content is used for binding advertisements.

Claims 380 and 423

Claim 380 has been amended to incorporate limitations related to those from dependent claims 383 and 387 (presently cancelled).

Swix does not disclose or suggest at least "self-guiding advertisements, each advertisement including advertising content and one or more of instructions, procedures, and software programs for binding the advertisement to the inventory," as recited by amended claim 380, or "self-guiding advertisements that include one or more of instructions, procedures, and software programs for binding the advertisement to the inventory," as recited by claim 423.

To the contrary, the advertisements would not need to include such instructions, procedures, or software programs for binding the advertisements to the inventory since Swix describes an approach in which binding decisions can be made at the head end 110 using the profile processor 104 and file server 102 after the advertisements have already been downloaded to the navigator memory buffer of the set-top box 108. For example, Swix describes (column 11, lines 34-57):

> The present invention delivers bit map or video advertisements from file server
> 102 to the plurality of set-top boxes 108. File server 102 can download each
> advertisement when a set-top box requests an advertisement for an advertisement
> insertion slot. However, in the preferred embodiment, file server 102 downloads a
> whole library of advertisements to the navigator memory buffer when the set-top
> box is initially activated and then instructs the navigator to retrieve from the
> buffer a certain advertisement and play that advertisement to the subscriber.
> Although storing the advertisements in the navigator memory buffer eliminates
> the delay associated with downloading bit maps or video each time one is
> displayed, this "look ahead" buffer strategy is limited by the cache size of the
> navigator memory. If the cache size is small and an advertisement cannot be
> stored, then the navigator simply reverts to querying file server 102 and waiting
> for the downloading of the bit map or video advertisement. Also, to save cache
> capacity, preferably, head end 110 initially screens the advertisements that are to
> be loaded ahead of time on the set-top box and removes the advertisements that
> would not appeal to that specific subscriber whatsoever. For example,

advertisements for women's wear would be removed from delivery to a male-only household.

Furthermore, there is nothing inherent in the approach described in Swix that would require advertisements to include such instructions, procedures, or software programs. Also, there is nothing to suggest that such instructions, procedures, or software programs are included with each advertisement. The Examiner's suggestion that Swix's advertisements "includes part of the instructions" (e.g., on page 14 of the Office Action) is not described or suggested by Swix, but rather appears to be based on the Applicant's own specification.
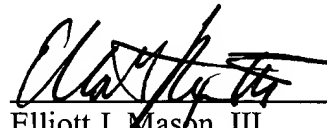
Dependent claims

The remaining claims are all properly dependent on one or more of the independent claims, and thus allowable therewith. Each of the dependent claims adds one or more further limitations that enhance patentability, but those limitations are not presently relied upon. For that reason, and not because applicants agree with the examiner, no rebuttal is offered to the examiner's reasons for rejecting the dependent claims.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 9-23-05

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